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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,876	08/18/2006	Jordi Tormo i Blasco	5000-0192PUS1	2828
2292 7590 12/23/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
12/23/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/589,876

**Applicant(s)**

BLASCO ET AL.

**Examiner**

JEFFREY H. MURRAY

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. After further consideration, the final rejection mailed on September 4, 2008 has been withdrawn. The following action is issued and replaces the non-final action dated September 4, 2008. The final rejection has been withdrawn from consideration. This action seeks to remedy examination of those claims.

This action is in response to an after-final amendment filed on November 5, 2008. There are ten claims pending and six claims under consideration. This is the third action on the merits. The present invention relates to 5, 6-dialkyl-7-amino-triazolo-pyrimidines, method for producing them, their use for controlling parasitic fungi and agents containing the same.

### ***Withdrawn Rejections/Objections***

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

### ***Claim Objections***

3. Claim 5 is an independent claim that claims a species of the generic claim. Multiple inventions may not be claimed in a single application unless they are species claims which are dependent upon the larger, generic claim, see C.F.R. § 1.141(a). Examiner recommends applicant make these claims dependent from Claim 1, or a broader genus claim from which they depend. No new matter is permitted. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

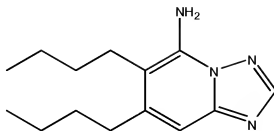
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken, et. al. U.S. Patent No. 4,617,303, in view of *In re Hass et al.* (CCPA 1944) 141 F2d 122 and 127, 60 USPQ 544 and 548; and *In re Henze* (CCPA 1950) 181 F2d 198, 85 USPQ 261.

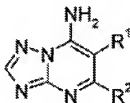
The present invention relates generally to novel 5, 6-dialkyl-7-amino-triazolo-pyrimidines compounds and compositions thereof. The active compounds of the present invention are useful in controlling parasitic fungi and agents containing the same.

Eicken, et. al. teaches a compound having the following structure:



as can be seen in example #16 in the table in columns 7 and 8.

The current application teaches a compound of the following structure:



Whereby R<sup>1</sup> can be C<sub>5</sub>-C<sub>9</sub> alkyl and R<sup>2</sup> can be an *n*-propyl or *n*-butyl group.

The above stated prior art compound is identical to a compound of the current application but for one aspect. The prior art compound contains a butyl group as the R<sup>1</sup> group. The current application claims that R<sup>1</sup> can be a C<sub>5</sub>-C<sub>9</sub>-alkyl group.

The CCPA has defined a homologous series as a family of chemically related compounds, the composition of which varies from member to member by a -CH<sub>2</sub> (one atom of carbon and two hydrogen). In re Coes, Jr. (CCPA 1949) 173 F2d 1012, 81 USPQ 369. The Court of Appeals for the District of Columbia applied a broader definition and defined a homolog (homologue) as a member of a series of compounds in which each member differs from the next member by a constant number of atoms. Carr. Pats.v. Deutsche Gold-und-Silber, etc. (CADC 1968) 397 F2d 656,157 USPQ 549.

The "Hass-Henze Doctrine" evolved from three CCPA cases, viz., *In re Hass et al.* (CCPA 1944) 141 F2d 122 and 127, 60 USPQ 544 and 548; and *In re Henze* (CCPA

1950) 181 F2d 198, 85 USPQ 261. In the *Henze* decision, the Court said:

"The nature of homologues and the close relationship the physical and chemical properties of one member of a series bears to adjacent members is such that a presumption of unpatentability arises against a claim directed to a composition of matter, the adjacent homologue of which is old in the art. The burden is on the applicant to rebut that presumption by a showing that the claimed compound possesses unobvious or unexpected beneficial properties not actually possessed by the prior art homologue. It is immaterial that the prior art homologue may not be recognized or known to be useful for the same purpose or to possess the same properties as the claimed compound. The CCPA concluded that because the characteristics normally possessed by members of a homologous series are principally the same, varying gradually from member to member, chemists knowing the properties of one member of a series would in general know what to expect in adjacent members so that a mere difference in degree is not the marked superiority which will ordinarily remove the unpatentability of adjacent homologues of old substances. Contra, where no use for the prior art compound is known. *In m Sterniski* (CCPA 1971) 444 F2d 581, 170 USPQ 343, and cases cited therein. Whether a compound is patentable over a prior art homologue or isomer is a question to be decided in each case. *In re Hass et al.*, *supra*."

The 'Hass-Henze Doctrine' stands for the proposition that, "If that which appears at first blush to be obvious though new is shown by evidence not to be obvious then the evidence prevails over surmise or unsupported contention and rejection based on obviousness must fail." *In re Papesch* (CCPA 1963) 315 F2d 381, 137 USPQ 43, 48. The presumption that homologues are unpatentably obvious is an inference of fact, viz., that adjacent homologs are expected to have similar properties which places a 'burden of persuasion' on the applicant who asserted a contrary fact. *In re Mills* (CCPA 1960) 281 F2d 218, 126 USPQ 513.

Compounds that differ only by the presence of an extra methyl group are homologs. Homologs are of such close structural similarity that the disclosure of a

compound renders *prima facie* obvious its homolog. The homolog is expected to be capable of preparation by the same method and to have the same properties. This expectation is then deemed the motivation for preparing homologs. Homologs are obvious even in the absence of a specific teaching to methylate, *In re Wood* 199 USPQ 137; *In re Hoke* 195 USPQ 148; *In re Lohr* 137 USPQ 548; *In re Magerlein* 202 USPQ 473; *In re Wiechert* 152 USPQ 249; *Ex parte Henkel* 130 USPQ 474; *In re Fauque* 121 USPQ 425; *In re Druey* 138 USPQ 39. In all of these cases, the close structural similarity of two compounds differing by only one (or two) methyl groups sufficed; no specific teaching to methylate was present or required. None of these cases has been overruled and indeed the examiner is unaware of any post *Lohr* case in which motivation is required to put a methyl group on an old compound.

One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound using the same method because the methyl group is not critical to the synthesis of the final compound and such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are *prima facie* obvious, absent a showing of unexpected results. *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).

### ***Conclusion***

6. Claims 1-4 and 8 are rejected.
7. Claim 8 is objected.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Patent Examiner , Art Unit 1624

/James O. Wilson/  
**Supervisory Patent Examiner, Art Unit 1624**